

REMARKS

This paper responds to the Office Action mailed on June 21, 2006.

Claims 1, 11, 18, 24, 29, 39, 45 and 51 are amended, no claims are canceled, and no claims are added; as a result, claims 1-60 remain pending in this application.

§101 Rejection of the Claims

Claims 1-60 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Office Action states that claims 1, 11, 18 and 24 are directed to a method of detecting conditions, in which claims recite measuring fabrication data, determining, storing, analyzing and examining the analysis, however no useful, concrete, and tangible result is produced such as using the analysis for control. The Office Action further states that claims 2-10, 12-17, 19-23 and 25-28 are included are included in this rejection because of their dependency. Applicant respectfully traverses.

Applicant presently amends Claims 1, 11, and 24 to recite, in part, “determining current conditions using the analysis” and claim 18 to recite “examining the analysis to determine current conditions.” Support for the amendment can be found at least at Page 11, Line 3 and Page 12, Line 30 of the present application. Applicant submits that as amended a tangible result is produced. Applicant respectfully requests withdrawal of the § 101 rejection with respect to Claims 1-28 for at least these reasons.

The Office Action states that claims 29, 39, 45 and 51 are directed to a method of responding to conditions, in which claims recite measuring fabrication data, determining, storing, analyzing, comparing the analysis and responding to the comparison, however no useful, concrete, and tangible result is produced such as using the analysis for control. The Office Action further states that claims 30-38, 40-44, 46-50 and 52-60 are included in this rejection because of their dependency. Applicant respectfully traverses.

Applicant presently amends Claims 29, 39, 45 and 51 to recite, in part, “determining current conditions using the analysis.” Support for the amendment can be found at least at Page 11, Line 3 and Page 12, Line 30 of the present application. Applicant submits that as amended a tangible result is produced, which is then used in “responding to the comparison.” Applicant

respectfully requests withdrawal of the § 101 rejection with respect to Claims 29-60 for at least these reasons.

§112 Rejection of the Claims

Claims 1-60 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claims 1, 11, 18 and 24 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between steps. Claims 30-38, 40-44, 46-50 and 52-60 are included in this rejection because of their dependency. Applicant respectfully traverses.

Applicant respectfully disagrees that the claims as originally filed omit any essential step. However, Applicant chooses to amend Claims 1, 11, 18, 24, 29, 39, 45 and 51 to more particularly point out and claim the subject matter. Applicant presently amends Claims 1, 11, 18, 24, 29, 39, 45 and 51 to recite, in part, “determining current conditions using the analysis.” Support for the amendment can be found at least at Page 11, Line 3 and Page 12, Line 30 of the present application. Applicant submits that as amended the claims do not lack any step for detection. Applicant respectfully requests withdrawal of the § 112, second paragraph rejection with respect to Claims 1-60 for at least these reasons.

§102 and §103 Rejections of the Claims

Claims 1-60 were rejected under 35 U.S.C. § 102(b) for anticipation by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Herberich et al. (U.S. 4,719,694). Applicant respectfully traverses.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”²

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of

¹ *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

obviousness.³ To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references.⁴

Applicant presently amends claims 1, 11, 24, 29, 39, 45 and 51 to remove the language that the Office Action asserted was vague. Claim 18 is amended to clarify this language. Applicant respectfully submits that Herberich does not state each and every element of claims 1-60 and as such does not make out a prima facie case of anticipation. Applicant fails to find in Herberich each and every element of claims 1-60. The Office Action fails to cite to any particular statement in Herberich, and merely asserts that Herberich discloses the elements and includes a figure from the document. For at least these reasons, Applicant respectfully requests the withdrawal of the rejection under 35 USC 102(b) and allowance of claims 1-60.

With respect to the assertion that claims 1-60 are non-obvious in light of Herberich, Applicant respectfully submits that for at least the reasons stated above, Herberich fails to state each and every element of claims 1-60 and in the absence of any other cited document, or an affidavit, Applicant respectfully requests withdrawal of the 35 USC 103(a) rejection and allowance of claims 1-60.

Interview Request

Applicant's below representative requests an interview with the examiner if the next action is not a notice of allowance. In particular, applicant requests an in-person interview on Wednesday, October 18, 2006.

³ *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁴ *Id.*

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date

21 Sept '06

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21 day of September 2006.

Name

KATHLEEN GANDON

Signature

